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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,577	10/03/2005	Hisato Uto	Q90071	3885

23373 7590 11/21/2007  
SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER
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SINGH, ARTI R

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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11/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,577	<b>Applicant(s)</b> UTO ET AL.	
	<b>Examiner</b> Ms. Arti Singh	<b>Art Unit</b> 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Prosecution Application***

***Response to Arguments***

1. Applicant's arguments see 10/29/07, with respect to the rejection(s) of claim(s) 1,2,4,5,7, and 8 as cited in the previous office action. Applicant's arguments have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of USPN 6183842 in view of JP 62-198455 A (as cited in the search report) further in view of USPN 7101644 issued to Toshine et al.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6183842 in view of JP 62-198455 A (as cited in the search report) further in view of USPN 7101644 issued to Toshine et al.

4. USPN 6183842 issued to Shimizu et al discloses making a decorative laminate comprising a substrate layer composed of a polyester type resin layer and a transfer foil laminated to it (abstract, column 4, line 31-column 5 line 5). The resin layer is may be embossed to created concavities to which the foil may be transferred upon (column4, line 63). Shimizu et al does not suggest scaring the resin layer.

Art Unit: 1794

As cited in the search report, which at this point the Examiner must believe, is true, since the Examiner cannot obtain the cited reference, nor has Applicant provided the same. However, the cited search report states that in Document 4 (JP 62-198455 under the heading "Effects of the Invention" that scraping is a well know technique and utilized by those skilled in the art. Thus, a skilled artisan would have found it obvious to manipulate the surface of Shimizu et al, instead of embossing. One would have been motivated to scrape by hand instead of utilizing a machine embossing treatment motivated by the desire to reduce economical costs in manufacturing said composite.

It should be noted the Merriam Webster's Dictionary defines scrape as

1 a : to remove from a surface by usually repeated strokes of an edged instrument b : to make (a surface) smooth or clean with strokes of an edged instrument or an abrasive  
2 a : to grate harshly over or against b : to damage or injure the surface of by contact with a rough surface c : to draw roughly or noisily over a surface. Both of these definitions read on embossing of a surface.

The above combination also fails to suggest the use of a release base layer. USPN 7101644 issued to Toshine et al. remedies this who teach the use of removable release layers (column 20) in foil/resin laminates. A person having ordinary skill in the art at the time the invention was made would have found it obvious to use a release layer in the composite of Shimizu and JP 62-198455. One would have been motivated to do so in order to prevent the migration of chemicals from one layer to the other, or alternatively assist in the transportation of rolls of such materials so that the layers don't stick to one another.

Art Unit: 1794

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 571-272-1483. The examiner can normally be reached on M-T 9-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Arti Singh/  
Primary Examiner  
Art Unit 1794

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